IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	: Srinivasan et al.		
Serial No.	: 09/805,336	Examiner :	J. Janvier
Filed	: March 13, 2001	Art Unit :	3688
For	: METHOD AND SYSTEM FOR CREATING AND ADMINISTERING INTERNET MARKETING PROMOTIONS		

October 1, 2008

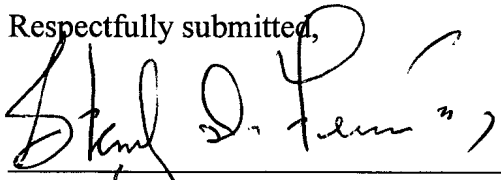
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed herewith. The review is requested for the reasons stated in the attached remarks.

Respectfully submitted,



Stanley D. Ference III
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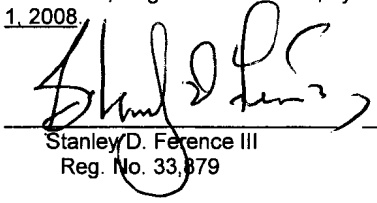
I hereby certify that this correspondence and any documents referred to as enclosed therewith are being filed with the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, by EFS Web on October 1, 2008.



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REMARKS

In the Office Action dated July 1, 2008, pending Claims 1-21 were finally rejected. Claims 1 and 18 are independent claims; the remaining claims are dependent claims. Claims 1 and 18 stand objected to. Claims 1-21 stand rejected under 35 U.S.C. §101 as being drawn to non-statutory subject matter. Claim 1 of the instant application stands provisionally rejected on the ground of non-statutory double patenting over claim 1 of co-pending App. Ser. No. 09/804,735. Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,918,014 to Robinson (hereinafter "Robinson"). Claims 1-21 also stand rejected under 35 U.S.C. 103 as being unpatentable over Lipsky, U.S. Patent No. 7,031,932 (hereinafter "Lipsky").

As an initial matter, Applicant objects to the Examiner's use of "Official Notice" throughout the Office Action. *Office Action*, pp. 18 and 22. It is well understood that:

> [a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore...any facts so noticed *should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner...It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.*

MPEP 2144.03(E) (citations omitted). In the instant case, it is not clear to Applicant what facts the Examiner is taking "notice" of or what reasoning underlies the use of official notice. There is also a complete lack of documentary support for the notices explicitly cited against the claims. As a non-limiting example, the Examiner states "it would have been obvious to...incorporate the above disclosure ("Official Notice") into the system of Robinson..." *Office Action*, pp. 18. Applicants disagree. Thus, Applicant respectfully submits that this is clear error.

Claims 1 and 18 stand objected to for using the phrase "the experiment" rather than "the method". (*Office Action*, pp. 5-6). Applicants respectfully suggest that this, along with the ambiguous "Official Notice" sections in the Office Action, appear to indicate a continued misunderstanding of the subject matter and language of the instantly claimed invention. The Examiner's attempts to mold the references' teachings, such that they are, to the elements of the claims based upon knowledge in the art misconstrues their teachings. Applicant therefore undertakes to briefly summarize the invention and the contents of the cited references.

The instantly claimed invention can determine an optimal promotion for the current market conditions. The invention "relates to *automatically* generating marketing promotions for Internet websites *based on real-time data obtained through controlled short-term experiments that determine market sensitivity.*" *Specification* at [0003]. The invention employs the "great deal of real-time transactional information [that] is available", giving businesses a way in which "promotion and other market sensitivities [can be] *measured directly through use of controlled real-time experiments*." *Id* at [0012] and [0017]. Thus, the instant invention "enables Internet businesses to conduct real-time, *online experiments on a sample of transactions and determine marketplace sensitivities.* Analysis of the results of the experiments reveal optimal values of key market decision variables..." *Id* at [0019]. "In particular, the present invention allows for designing and administering *Internet promotions via a website based on the observed characteristics and behavior of customers visiting the website.*" *Id* at [0023].

In an experiment "*promotions are deliberately varied* by the inventive system during a sampling period ...to determine what percentage of customers are likely to

buy...when offered various promotions." *Id* at [0075]. "[T]he system is able to compute an optimal...level of promotions. The optimal promotion...is intended to optimize an economic variable, such as profit." *Id* at [0076]. There is a specific example given in the specification at [0102]-[0108].

The teachings of the references cited by the Examiner stand in stark contrast to the instantly claimed invention. In addition to relying on segmentation, Robinson does not provide a plurality of promotions to determine, *through experimentation* (short-term, real-time or otherwise), which is *the* optimal promotion *for current market sensitivities*. The Examiner is incorrect to characterize Robinson's handling of *a single new advertisement* as being at all similar to the workings of the instantly claimed invention. Robinson merely displays the new advertisement (one, i.e. singular) to users and waits to develop data on that one advertisement. *Robinson*, Col. 19, lines 6-9.

Lipsky operates an advertising service system (120) to place advertisements on another publisher's website (130) in order to entice a user (**112**) visiting that site to visit yet another Internet advertiser's site (160). *Lipsky*, Fig. 1 (and accompanying text). Aside from the conspicuous difference that multiple websites and parties are involved, Lipsky passively tracks the performance of *the current advertisements in use on many sites* (placements/campaigns). *Id.* Col. 2, lines 34-61. Subsequently, the system regulates particular advertisements, which may involve negotiations between the parties to the advertising scheme. *Id* at Col. 2, line 62-Col. 3, line 15. As already acknowledged by the Examiner, this is different from sampling a fraction of current visitors to a website to experiment with various different promotions for the express purpose of determining a currently optimal promotion. (*Office Action*, pp. 22). Thus, the Examiner relies again on

an "Official Notice" for this teaching. *Id.* Applicants respectfully submit that these references both clearly fall short of the instantly claimed invention and use of "Official Notice" to overcome these deficiencies is clear error.

Claims 1-21 stand rejected under 35 USC 101 as being related to "mental processes", containing a "nominal" recitation of "Internet website" and not running the promotions on visitors to the website. *Id*, pp. 6. Applicants respectfully disagree. The claimed invention includes, *inter alia*, "*...presenting a plurality of varied promotions to different visitors*"...and "...dynamically determining an optimal promotion..." and "*...thereafter displaying the optimal promotion....*" Claim 1 (emphasis added). Clearly these claims are directed to a statutory class (process) and have a practical application.

Claim 1 stands provisionally rejected based upon non-statutory double patenting with regard to co-pending Application (09/804,735). *Office Action*, pp. 6-10. Applicant respectfully disagrees with the Examiner's unsupported conclusion that "the terms advertisement and promotion are used interchangeably in the art, as one skilled in the art would have concluded..." *Office Action*, pp. 9. Applicant respectfully submits that the claims are patentably distinct and request reconsideration and withdrawal of this rejection.

Based upon the foregoing, Applicant respectfully submits that the cited art clearly falls short of the instantly claimed invention. The instant application, including claims 1-21, is directed to statutory subject matter and patentably distinct from the co-pending application. Therefore, the application is currently in condition for allowance. Notice to this effect is hereby earnestly solicited.